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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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AGILENT TECHNOLOGIES, INC.
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EXAMINER

SISSON, BRADLEY L

ART UNIT PAPER NUMBER

1634

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,937

Applicant(s)

YAKHINI ET AL.

Examiner

Bradley L. Sisson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2005 and 28 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-14, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Specification

1. The specification is objected to as documents have been improperly incorporated by reference. In particular, the specification states that the various cited documents are not incorporated by reference "in their entirety."

Such omnibus language fails to specify what specific information applicant seeks to incorporate by reference and similarly fails to teach with detailed particularity just where that specific information is to be found in each of the cited documents.

Attention is also directed to MPEP 608.01(p)I, which, in pertinent part, is reproduced below:

Mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. In re de Seversky, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). In addition to other requirements for an application, the referencing application should include an identification of the referenced patent, application, or publication. Particular attention should be directed to specific portions of the referenced document where the subject matter being incorporated may be found. (Emphasis added)

As set forth In *Ex parte* Raible, 8 USPQ2d 1707, (BPAI, 1998)

The examiner is of the opinion that the general incorporation by reference of the Bentley disclosure in appellant's specification is insufficient to support the specific disputed limitations of the present claims in the manner required by section 112 of the statute. We agree

* * *

We believe that the doctrine of incorporation by reference is of no avail to appellant in this regard since there is no specific indication in the instant specification of the particular features disclosed by Bentley which correspond to those intended for use in the here-claimed device; nor does the specification identify the specific portions of the patent which appellant may have intended to rely upon to supplement his disclosure. The purpose of incorporation by reference in an application of matter elsewhere written down is for economy, amplification, or clarity of exposition, by means of an incorporating

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statement clearly identifying the subject matter which is incorporated and where it is to be found. In re de Seversky, 474 F.2d 671, 177 USPQ 144, (CCPA 1973).

Accordingly, the cited documents are not considered to have been properly incorporated by reference and as such, have not been considered with any effect towards their fulfilling, either in part or in whole, the enablement, written description, or best mode requirements of 35 USC 112, first paragraph.

Response to argument

At page 9, bridging to page 10 of the response received 28 February 2005, applicant's representative asserts that the specification, as amended, clearly states where the relevant portion(s) of the documents are to be found- somewhere within the entire disclosure, with the exception of *Molecular Cloning* (page 34 of specification), for which said representative asserts that the artisan can simply determine what is relevant from a review of the index.

The above argument is not persuasive for the amendment to the specification introduces new matter to the disclosure. Further, the added language, even if not new matter still fails to clearly indicate just what information applicant (not the public at some later date) considers to be relevant, and just what are the pertinent parts of each document. Accordingly, the objection is maintained.

2. The amendment filed 28 February 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The text added to pages 5, 10, 15, 17, 23, 30,

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32, and 34 of the disclosure wherein said pages were amended to reflect that cited documents were incorporated by reference “in its entirety,” “in their entirety,” etc.

3. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 10-14, 17, and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

6. Attention is directed to the decision in *University of Rochester v. G.D. Searle & Co.* 68 USPQ2D 1424 (Fed. Cir. 2004) at 1428:

To satisfy the written-description requirement, the specification must describe every element of the claimed invention in sufficient detail so that one of ordinary skill in the art would recognize that the inventor possessed the claimed invention at the time of filing. *Vas-Cath*, 935 F.3d at 1563; see also *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 [41 USPQ2d 1961] (Fed. Cir. 1997) (patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that “the inventor invented the claimed invention”); *In re Gosteli*, 872 F.2d 1008, 1012 [10 USPQ2d 1614] (Fed. Cir. 1989) (“the description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed”). Thus, an applicant complies with the written-description requirement “by describing the invention, with all its claimed limitations, not that which makes it obvious,” and by using “such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention.” *Lockwood*, 107 F.3d at 1572.

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7. As presently worded, the method of claim 10, one is to have the "first plurality" of nucleic acids immobilized on a surface. There is no further requirement as to how the "first plurality" is immobilized. Accordingly, the claim has been interpreted as encompassing a simple dot or spot where all of the nucleic acids of the "first plurality" are immobilized. While one is to in effect create a sandwich hybridization product between the "first plurality," the "second plurality," and the "target" as found in a biological sample, the signal(s) generated, would all be at the same place. While each and every nucleic acid of the first is different from every other member of the first group, as is every member of the second group different from one another and is complementary to each different member of the first group, one would not be able to determine which sequence has undergone hybridization with what.

8. With every member of the first group and every member of the second group being different from every other member, the level of detection is ultimately on the level of a single molecule. A review of the disclosure fails to find the requisite full, clear, and concise description of where one would be able to detect single molecules.

9. In view of the preceding remarks, it is deemed that the instant disclosure fails to reasonably suggest that applicant was in possession of the invention of claims 10-14 at the time of filing.

10. In considering the method of claims 17 and 18, one is to hybridize the "first plurality," but no statement is made as to what the first plurality is to be hybridizing to. A review of the disclosure fails to find where one has hybridization to no complementary sequence, or to self when the sequences are different from each other.

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11. As presently worded, the claimed method encompasses the use of an array, however, the specification does not provide a full, clear, and concise description of the full range of array spot density, the full range of lengths of sequences used as the first, second, and target nuclei acids.

It appears that applicant is attempting to satisfy the written description requirement of 35 USC 112, first paragraph, through obviousness. Obviousness, however, cannot be relied upon for satisfaction of the written description requirement. In support of this position, attention is directed to the decision in *University of California v. Eli Lilly and Co.* (Fed. Cir. 1997) 43 USPQ2d at 1405, citing *Lockwood v. American Airlines Inc.* (Fed. Cir. 1997) 41 USPQ2d at 1966:

Recently, we held that a description which renders obvious a claimed invention is not sufficient to satisfy the written description requirement of that invention.

12. In view of the preceding remarks, it is deemed that the instant disclosure fails to reasonably suggest that applicant was in possession of the invention of claims 17 and 18 at the time of filing.

13. Claims 10-14, 17, and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As set forth in *Enzo Biochem Inc., v. Calgene, Inc.* (CAFC, 1999) 52 USPQ2d at 1135, bridging to 1136:

To be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation.' "*Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365, 42 USPQ2d 1001, 1004 (Fed. Cir. 1997) (quoting *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513

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(Fed. Cir. 1993)). Whether claims are sufficiently enabled by a disclosure in a specification is determined as of the date that the patent application was first filed, see *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986).... We have held that a patent specification complies with the statute even if a "reasonable" amount of routine experimentation is required in order to practice a claimed invention, but that such experimentation must not be "undue." See, e.g., *Wands*, 858 F.2d at 736-37, 8 USPQ2d at 1404 ("Enablement is not precluded by the necessity for some experimentation . . . However, experimentation needed to practice the invention must not be undue experimentation. The key word is 'undue,' not 'experimentation.' ") (footnotes, citations, and internal quotation marks omitted). In *In re Wands*, we set forth a number of factors which a court may consider in determining whether a disclosure would require undue experimentation. These factors were set forth as follows: (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. *Id.* at 737, 8 USPQ2d at 1404. We have also noted that all of the factors need not be reviewed when determining whether a disclosure is enabling. See *Amgen, Inc. v. Chugai Pharm. Co., Ltd.*, 927 F.2d 1200, 1213, 18 USPQ2d 1016, 1027 (Fed. Cir. 1991) (noting that the *Wands* factors "are illustrative, not mandatory. What is relevant depends on the facts.").

14. As set forth above, the specification does not reasonably suggest that applicant was in possession of the invention at the time of filing. It is well settled that one cannot enable that which they do not yet possess. Accordingly, claims 10-14, 17, and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

15. The method of claims 10-14, 17, and 18 fairly encompass the use of arrays of nucleic acids. The claims place no restriction on the density of the nucleic acids at each of the array spots, the proximity of one spot to another, the length of the immobilized nucleic acids, or on the length of the target sequences. With each nucleic acid in the first group and each nucleic acid in the second group being different from one another, it stands to reason that there will be members of the first group that are complementary to one another and that there are also members of the second group that are complementary to one another.

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16. While the level of the art of arrays and hybridization has undergone much development, said development has also recognized certain inherent problems. The art to which the invention relates, i.e., nucleic acid array art and hybridization art, has advanced to the point that certain problematic areas have been identified. In support of this position as it relates to the manufacture and use of oligonucleotide arrays, US Patent 6,077,674 (Schleifer et al.) addresses certain highly problematic areas:

While in situ synthesis is a very flexible means for producing DNA arrays, the fidelity or percentage of full-length oligonucleotides synthesized within a feature on the array is less than 100 percent. An ideal array will have only full-length oligonucleotides attached to each feature. The ideal array promotes accuracy in hybridization experiments or assays or target biological materials. If the fidelity of an in situ generated array is less than 100 percent, it typically has non full-length oligonucleotides within a feature that usually consists of shorter lengths of the correct sequence, and to a lesser degree, incorrect sequences. Typical DNA coupling efficiencies are around 97 to 99 percent for the standard phosphoramidite chemistry. For oligonucleotides that are 25 nucleotides in length, these efficiencies result in only 46 to 77 percent full-length oligonucleotides contained within a feature (0.97^{25} to 0.99^{25}). This loss of fidelity can cause chemical noise in hybridization conditions. The loss of fidelity can also lead to difficulty in interpreting the data.

Photolithography is a method used by Affymetrix in California to produce in situ arrays using procedures that are similar to those used in the semi-conductor industry. In procedure described by Fodor et al. from Affymetrix U.S. Pat. No. 5,405,783, a photo-deprotection step is used where the protecting group on the phosphoramidite is removed by exposing a photosensitive protecting group to light. Four photo masks are used to create patterns to de-protect areas of the substrate and then a nucleotide is added to these regions. This technique requires four masks for each layer of nucleotides. While this technique allows for the production of high-density oligonucleotide arrays, it is less efficient than traditional phosphoramidite synthesis chemistry. With efficiencies of about 90 to 95 percent, the percentage of full-length oligonucleotides within a feature is further reduced to about 9 to 27 percent for oligonucleotides that are 25 nucleotides long (0.90^{25} to 0.95^{25}).

17. Carrico, (US Patent 5,200,313) similarly identifies problematic aspects of hybridization reactions:

1. The purity of the nucleic acid preparation.

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2. Base compositions of the probe - G-C base pairs will exhibit greater thermal stability than A-T or A-U base pairs. Thus, hybridizations involving higher G-C content will be stable at higher temperatures.

3. Length of homologous base sequences- Any short sequence of bases (e.g., less than 6 bases), has a high degree of probability of being present in many nucleic acids. Thus, little or no specificity can be attained in hybridizations involving such short sequences. From a practical standpoint, a homologous probe sequence will often be between 300 and 1000 nucleotides.

4. Ionic strength- The rate of reannealing increases as the ionic strength of the incubation solution increases. Thermal stability of hybrids also increases.

5. Incubation temperature- Optimal reannealing occurs at a temperature about 25 - 30 °C below the melting temperature for a given duplex. Incubation at temperatures significantly below the optimum allows less related base sequences to hybridize.

6. Nucleic acid concentration and incubation time- Normally, to drive the reaction towards hybridization, one of the hybridizable sample nucleic acid or probe nucleic acid will be present in excess, usually 100 fold excess or greater.

7. Denaturing reagents- The presence of hydrogen bond-disrupting agents, such as formaldehyde and urea, increases the stringency of hybridization.

8. Incubation- The longer the incubation time, the more complete will be the hybridization.

9. Volume exclusion agents- The presence of these agents, as exemplified by dextran and dextran sulfate, are thought to increase the effective concentrations of the hybridizing elements thereby increasing the rate of resulting hybridizations.

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18. Further, subjecting the resultant hybridization product to repeated washes or rinses in heated solutions will remove non-hybridized probe. The use of solutions of decreasing ionic strength, and increasing temperature, e.g., 0.1X SSC for 30 minutes at 65 °C, will, with increasing effectiveness, remove non-fully complementary hybridization products.

19. The instant disclosure is essentially silent as to how these art-recognized issues would be overcome. Likewise, no convincing evidence has been made of record, which shows that these issues have been overcome in the art.

20. A review of the disclosure finds but two examples:

- a. Example 1, page 40, "Incorporation of the 2-amino-2'-deoxyadenosine-5'-triphosphate and 2-thiothymidine-5-triphosphate into Polynucleotides by DNA Polymerase;" and
- b. Example 2, page 44, "Synthesis of Single Stranded Polynucleotides."

21. As is plainly evident above, none of these examples describes the claimed method of sequencing any nucleic acid.

The situation at hand is analogous to that in *Genentech v. Novo Nordisk A/S* 42 USPQ2d 1001.

As set forth in the decision of the Court:

“ '[T]o be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation.' *In re Wright* 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); *see also Amgen Inc. v. Chugai Pharms. Co.*, 927 F. 2d 1200, 1212, 18 USPQ2d 1016, 1026 (Fed Cir. 1991); *In re Fisher*, 427 F. 2d 833, 166 USPQ 18, 24 (CCPA 1970) ('[T]he scope of the claims must bear a reasonable correlation to the scope of enablement provided by the specification to persons of ordinary skill in the art.').

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“Patent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable. *See Brenner v. Manson*, 383 U.S. 519, 536, 148 USPQ 689, 696 (1966) (starting, in context of the utility requirement, that ‘a patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion.’) Tossing out the mere germ of an idea does not constitute enabling disclosure. While every aspect of a generic claim certainly need not have been carried out by an inventor, or exemplified in the specification, reasonable detail must be provided in order to enable members of the public to understand and carry out the invention.

“It is true . . . that a specification need not disclose what is well known in the art. *See, e.g., Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385, 231 USPQ 81, 94 (Fed. Cir. 1986). However, that general, oft-repeated statement is merely a rule of supplementation, not a substitute for a basic enabling disclosure. It means that the omission of minor details does not cause a specification to fail to meet the enablement requirement. However, when there is no disclosure of any specific starting material or any of the conditions under which a process can be carried out, undue experimentation is required; there is a failure to meet the enablement requirement that cannot be rectified by asserting that all the disclosure related to the process is within the skill of the art. It is the specification, not the knowledge of one skill in the art, that must supply the novel aspects of an invention in order to constitute adequate enablement. This specification provides only a starting point, a direction for further research. (Emphasis added)

22. In view of the breadth of scope claimed, the limited guidance provided, the unpredictable nature of the art to which the claimed invention is directed, and in the absence of convincing evidence to the contrary, the claims have not been found to be enabled by the disclosure.

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

24. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (571) 272-0751. The examiner can normally be reached on 6:30 a.m. to 5 p.m., Monday through Thursday.

26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached on (571) 272-0745. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

27. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bradley L. Sisson
Primary Examiner
Art Unit 1634

BLS
10 September 2005